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DEC 11 2006

Remarks

This is responsive to the Office Action mailed October 11, 2006. The remarks are proper and serve to reiterate reasons why all pending claims are in condition for allowance. Absent the requested reconsideration, the remarks further serve to explain why this case is not in condition for appeal.

Rejection Under 35 U.S.C. §101

Claims 16-20 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner is obligated to examine the claims completely in view of statutory requirements for patentability from the beginning:

Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review....USPTO personnel must begin examination by determining what, precisely, the applicant has invented and is seeking to patent, and how the claims relate to and define that invention.  
(MPEP 2106, emphasis added)

The Examiner apparently first attempted to fulfill that obligation in the initial examination, and in the three examinations following it. In the initial examination the Examiner based the rejection on obviousness:

Claim 16 is directed to a method implementing the storage system as set forth in claim 1. Since Bowes and Cloke teach the storage system as set forth in claim 1; therefore, they also teach the method as set forth in claim 16.  
(Office Action of 3/16/2004, pg. 9, emphasis added)

Applicant obviated that rejection in its response filed 6/16/2004. The Examiner then changed the basis for the rejection to anticipation over Cloke:

As to claim 16, Cloke teaches a method comprising steps of: (a) providing data via a bus (fig. 1D element 36 col. 21 lines 57-63 wherein digital read data is conveyed to a controller 32 via a channel data bus that coupled to the bus 36 through the channel chip 26); (b) updating at least one register or parameter via the bus (fig. 5 col. 27 line 55 to col. 28 line 2); and (c) providing data via the bus responsive to the updating (col. 27 line 67 to col. 28 line 2 wherein read or write operations in the new data zone band is provided via the bus 36 after the register or parameter is updated).  
(Office Action of 11/5/2004, ppg. 3-4, emphasis added)

Applicant obviated that rejection in its response filed 3/4/2005. The Examiner then changed the basis for the rejection to anticipation over Liu:

As to claim 16, Liu teaches a method comprising steps of: (a) providing data via a bus (computer data bus 215 of fig. 2 and col. 8 lines 28-34, 61-64); (b) updating at least one register or parameter via the bus (fig. 3 and col. 8 lines 34-49, 64-67); and (c) providing data via the bus responsive to the updating (col. 8 lines 43-49 and col. 9 lines 3-12).  
(Office Action of 5/12/2005, pg. 3; Office Action of 10/25/2005, pg. 3, emphasis added)

Applicant obviated that rejection in its response filed 12/27/2005. The record is clear that for the first 22 months of prosecution the Examiner apparently viewed claim 16 to recite statutory subject matter under Section 101.

However, claim 16 was then rejected for reciting nonstatutory subject matter in the Office Action of 1/24/2006, and now stands finally rejected for that reason in the pending Office Action of 10/11/2006. Despite the long-existing prima facie precedence in the record that claim 16 is statutory subject matter, the Examiner ignored his obligation to substantiate his subsequent allegation that it is nonstatutory subject matter:

The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed

subject matter falls outside all of the statutory categories,  
they must provide an explanation.  
(MPEP 2106, emphasis added)

Rather than provide an explanation, here the Examiner merely paraphrased the claim language to spin a conclusory statement that the claimed subject matter lacks practical application for no concrete or useful result:

The claims detail manipulation of information in a [sic] in a register or parameter and providing information over a bus, which lacks practical application because the claims have no concrete or useful application/result.  
(Office Action of 10/11/2006, pg. 2)

It is curious that the Examiner ignores the claim language in concluding that the claim recites nonstatutory subject matter, when the Examiner explicitly recited the claim language in rejecting the subject matter for being obvious or anticipated by cited references. In obviating each of those rejections, Applicant relied expressly on the recited claim language as well, which recites *providing data via a bus; updating at least one register or parameter via the bus....*

The legal requirement for the invention to be “useful” is that it must meet the utility requirements of Section 101 by being (i) specific, (ii) substantial, and (iii) credible. (MPEP 2106) The present embodiments as claimed specifically recites both providing data and updating a register over the same bus. The Examiner had no qualms with the claimed embodiments being specific, substantial, and credible when he was reading the recited limitations onto a number of cited references. In fact, the record reveals that in each rejection it was pointed out that the cited references do not disclose or suggest all the recited features of the rejected claim. In rejecting the claim now for reciting nonstatutory subject matter, the Examiner provides no substantiating evidence

whatsoever that the claimed invention is not useful. Not only is the unsubstantiated basis insufficient in the law, it directly contradicts the usefulness the Examiner previously found in the claimed invention when rejecting it over cited art.

The legal requirement for the invention to be "concrete" is that the result be repeatable. (MPEP 2106) Again, the Examiner raised no question of the invention's concreteness when he explicitly read the claim limitations on a number of cited references. Furthermore, in rejecting the claim now for being nonstatutory subject matter, the Examiner provides no substantiating evidence whatsoever that the claimed invention is not concrete. Not only is the unsubstantiated basis insufficient in the law, it directly contradicts the concreteness the Examiner previously found in the claimed invention when rejecting it over cited art.

Applicant believes the only reasonable conclusion from the facts in the record is that the Examiner is attempting to use Section 101 as a safe harbor in which to reject claim 16 after repeatedly being unable to substantiate either an anticipatory or an obviousness rejection. The Examiner's attempt to do so is clearly reversible error because it ignores almost two years of prima facie evidence that claim 16 does recite statutory subject matter, which the Examiner attempts to displace by an unsubstantiated allegation that it does not recite statutory subject matter.

Accordingly, Applicant believes the rejection of claim 16 is inappropriate in the law. Reconsideration and withdrawal of the rejection is respectfully requested.

Absent reconsideration, a Pre-brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of nonstatutory subject matter. This approach is consonant with the Office's obligation to

develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). Applicant believes that if justice prevails a Panel will find this case in not in condition for appeal, due to the unresolved factual issue that the Examiner has not substantiated a prima facie case of unpatentability with regard to the requirements of Section 101.

**Rejection of Claims Under 35 U.S.C. §102(b)**

Claims 1-3, 5, 16, 18 and 19 stand rejected as being anticipated by U.S. Patent No. 5,276,564 to Hessing '564. This rejection is respectfully traversed.

Applicant reiterates that the Examiner has failed to provide a prima facie case of anticipation of claim 1 by not substantiating evidence in the record that Hessing '564 identically discloses *retrieving a first portion of the recorded data via the bus; updating some of the registers via the bus...* as claimed. Applicant further reiterates that the Examiner has failed to substantiate a prima facie case of anticipation of claim 16 by not substantiating evidence in the record that Hessing '564 identically discloses *providing data via a bus; updating at least one register or parameter via the bus...* as claimed. (see Applicant's Response of 7/24/2006, ppg. 12-14)

Hessing '564 discloses transferring recorded data from read channel 12 to data path controller 26 via a serial data bus formed by decoded serial read data path 36 and read clock path 38. (Hessing '564, col. 3 lines 25-27). Hessing '564 further discloses using a separate system bus 50 to pass data from ROM 23 to timing generator 20 to update registers 74, 76. (Hessing '564, col. 5 lines 24-26) The skilled artisan readily

recognizes the serial data bus and the system bus in Hessing '564 to be different and separate data paths.

However, the Examiner has maintained the rejection and made it final by stating that the claim term "bus" can reasonably be construed as "*all signal lines connecting items 12, 20 and 26....*" (Office Action of 10/11/2006, pg. 3) This reasoning leads the Examiner to the absurd conclusion that two buses connecting different components are part of the same bus. That is, the Examiner's construction requires that the serial data bus (connecting the read channel 12 and the controller 26) and the system bus (connecting the servo timing generator 20 and the controller 26) form a single bus.

Even the dictionary definition the Examiner relies on reveals that his claim construction is unreasonable: "The Microsoft Computer Dictionary, cited as extrinsic evidence defines a bus as "a set of hardware lines used for data transfer among components of a computer system...." (Office Action of 10/11/2006, pg. 9) Applicant reiterates that, in fact, Hessing '564 discloses no signal paths that are "used for data transfer" among the read channel 12, controller 26, and servo timing generator 20 as the Examiner alleges. (see Applicant's Response of 7/24/2006, pg. 13)

The Examiner's claim construction is clearly erroneous for being unreasonably broad because it ignores the plain meaning of the term *bus* consistent with its usage in the specification, thereby ignoring explicitly recited claim terms. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

The Examiner has failed to provide the requisite prima facie case of anticipation by not substantiating evidence in the record that the cited reference identically discloses all the recited features of independent claims 1 and 16. Reconsideration and withdrawal

of the present rejection of claims 1 and 16 and the claims depending therefrom are respectfully requested.

Absent reconsideration, a Pre-Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Before a closing of the merits, Applicant is entitled to an evidentiary showing that the cited reference identically discloses all the recited features of the rejected claims. Applicant has argued in the record that Hessing '564 does not identically disclose the recited features of the rejected independent claims. The merits of that debate cannot rightfully end on the basis of a clearly erroneous claim construction which reads the two different and separate data paths of Hessing '564 as forming a common data bus. Such an erroneous claim construction does not form any bona fide basis for an appealable issue. Applicant believes that if justice prevails a Panel will find that this case is not in condition for appeal due to the unresolved factual issue that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a prima facie case of anticipation.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

Claim 4 stands rejected as being unpatentable over Hessing '564 in view of Du '085. Claim 17 stands rejected as being unpatentable over Hessing '564 in view of

O'Brien '853. Claim 20 stands rejected as being unpatentable over Hessing '564 in view of Taniai '665.

These rejections are respectfully traversed on the basis that these claims depend from a patentable base claim, for reasons above, and provide additional limitations thereto. Moreover, these rejections are traversed on the basis that none of these references, alone or in combination, serve to make up for the deficiencies of Hessing '564 with regard to teaching or suggesting the claimed subject matter. Reconsideration and withdrawal of the rejections of these claims are respectfully requested.

#### **Allowable Subject Matter**

The Applicant gratefully acknowledges the allowance of claims 6-15.

#### **Conclusion**

This is a complete response to the Office Action of October 11, 2006.

Reconsideration and allowance of all pending claims are respectfully requested.

Applicant has also filed herewith a request for a telephone interview. The interview is necessary should the Examiner not pass all pending claims to allowance, in order to resolve the issues making this case not in condition for appeal.



Should any questions arise concerning this application, the Examiner is encouraged to contact the below signed attorney.

Respectfully submitted,

By:



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PTOL-413A (09 06)

Approved for use through 03/31/2007, OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

**Applicant Initiated Interview Request Form**

Application No.: 09 /494,787 First Named Applicant: John A. Mount  
 Examiner: Eron Sorrell Art Unit: 2182 Status of Application: Pending

**Tentative Participants:**

(1) Examiner Sorrell (2) Mitchell K. McCarthy  
 (3) \_\_\_\_\_ (4) \_\_\_\_\_

Proposed Date of Interview: To be determined by Examiner Proposed Time: \_\_\_\_\_ (AM/PM)

**Type of Interview Requested:**

(1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: \_\_\_\_\_

**Issues To Be Discussed**

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej.</u>	<u>1</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>Obj.</u>	<u>6</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) <u>Obj.</u>	<u>15</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) <u>Rej.</u>	<u>16</u>	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☒ Continuation Sheet Attached

**Brief Description of Arguments to be Presented:**

Interview is necessary to resolve issues making this case not in condition for appeal.

An interview was conducted on the above-identified application on \_\_\_\_\_.

**NOTE:** This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature

Examiner/SPE Signature

Mitchell K. McCarthy

Typed/Printed Name of Applicant or Representative

38,794

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, RMS

Continuation Sheet for Form PTOL-413a

SN 09/494,787

(5) Rej 21